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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,828	11/24/2003	Marc Husemann	tesa 1628-WCG	5350

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EXAMINER	
ZALUKAEVA, TATYANA	

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/720,828	HUSEMANN ET AL.	
	Examiner	Art Unit	
	Tatyana Zalukaeva	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. At the present time no restriction between PSA and method of its using has been made, however, if claims are further amended or added, such restriction may be imposed on any stage of the prosecution.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 8, are rejected under 35 U.S.C. 102(e) as being anticipated by Storbeck et al (Us 2003/0143413)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Storbeck discloses a pressure sensitive adhesive (abstract) comprising at least one block copolymer comprising at least one unit P(A)-P(B)-P(A) comprising at least one polymer block P(B) and at least two polymer blocks P(A), where P(A) independently of one another represent homopolymer or copolymer blocks of monomers A, the polymer blocks P(A) each having a softening temperature in the range from +20C. to +175C.,

P(B) represents a homopolymer or copolymer block of monomers B, the polymer block P(B) having a softening temperature in the range from -130C. to +10C., (see 0022-0025). Monomers are used in one of the embodiments that carry polar groups (0016). This expressly meets the limitations of claims 1-4 and 8.

4. Claims 1-5, 8, 11, 14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Husemann et al (U.S. 2003/0119970)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Disclosed is pressure sensitive adhesive, at least one block copolymer being composed at least in part on the basis of (meth)acrylic acid derivatives, additionally at least one block copolymer comprising at least the unit P(A)-P(B)-P(A) composed of at least one polymer block P(B) and at least two polymer blocks P(A), the polymer blocks P(A) each

having a softening temperature in the range from +20 C to +175C., and the polymer block P(B) having a softening temperature in the range from -130C to +10C (abstract)

This at least one block copolymer can be described by one or more of the following general formulae:

P(A)-P(B)-P(A) (I)

P(B)-P(A)-P(B)-P(A)-P(B) (II)

[P(B)-P(A)]nX (III)

[P(B)-P(A)]nX[P(A)]m (IV),

[0032] where n=3 to 12, m=3 to 12, and X is a ***polyfunctional branching unit***, i.e., a chemical building block via which different polymer arms are linked to one another;

[0033] where the polymer blocks P(A) independently of one another represent homopolymer and/or copolymer blocks of the monomers A, the polymer blocks P(A) each having a softening temperature in the range fom +20C. to +175C where the polymer blocks P(B) independently of one another represent homopolymer and/or copolymer blocks of the monomers B, the polymer blocks P(B) each having a softening temperature in the range from -130C. to +10C (0031-0035). See also Table 1 in 0149.

5. Claims 1-15 are rejected under 35 U.S.C. 102(a/e) as being anticipated by Husemann et al (US 20030073767)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. See abstract, , 0020, especially 0028 and 0029 and 0034. With specific regard to claim 7 see 0050, claims 10 and 16. Since the amount of blocks (B) is taught to be 10-60%, the amount of blocks (A) or (A/C) is inherently within the claimed range. Tape of claim 15 is disclosed at least in 0088.

With regard to repulpability of the claimed pressure sensitive adhesives, the above rejections were made in the sense of r ***In re Spada***, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), which settles that **when** the claimed compositions **are not novel**, they are not rendered patentable by recitation of properties, whether or **not** these properties are shown or suggested in prior art. In the other words, the compound and its properties are inseparable, and since all the polymers disclosed in the prior art are identical to those claimed they will also be repulpable.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Husemann et al (US 20030073767) in view of U.S. Pat. No. 4,413,082 to Gleichenhagen, et al.

Gleichenhagen teaches a water soluble pressure-sensitive adhesive composition for repulpable splicing tape comprising from 30 to 80 parts of a copolymer of 70 to 88% by weight of butyl acrylate of which 5 to 25% can be a mixture of vinyl acetate and fumaric acid dialkyl ester and 12 to 30% by weight vinyl carboxylic acid blended with from 20 to 70 parts by weight of a water soluble plasticizer which is ethoxylated alkyl phenol, ethoxylated alkyl mono or diamine and from 2 to 30 parts by weight of an acidic rosin. The adhesive is water soluble and contains more than 10% of vinyl carboxylic acid in the polymer. Since the copolymers of Gleichenhagen are substantially similar to the polymers of the instant claims and the polymers of Husemann, it would have bee obvious to utilize them for splicing of paper with the reasonable expectation of success.

7. Claims 1-15 are rejected under U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 1O3(a) as obvious over Otsu et al. 5,314,962.
Otsu discloses a process o producing ABA triblock copolymers and their utility as adhesive (col. line 65 to col. line 34). Specifically, prior art block A is defined by M2, which can be methyl methacrylate and styrene derivatives (col. 4,
1. which can be lines 1-29); block is defined by M w copolymers of alkyl (methacrylates and (methacrylic acids as (A/C) of the present claims (col. Lines 68). Prior art product contains molecular weight and glass transition temperature in the instant ranges (col. Line to col. line 39; working examples).

8. Claims 1-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. l03(a) obvious over EP 1 008 640.

9. EP-270 discloses a PSA composition block copolymer comprising an ABA, which falls within the definition of the instant P(B)-P(A/C)-P(B) copolymer having the recited Tg (page 3, line 38 to page 4 line 16). Specifically, prior art elastomeric block may be (meth)acrylate copolymerized with up to 25% polar monomer as instantly claimed page 5, line 23 to page 6, line 11). Triblock copolymers which are within the scope of the present claims are exemplified (Examples 2-5). Hence, anticipating PSA composition based by ABA block copolymer containing at least two styrene block A and an acrylic block B. Prior art acrylic monomer block can be copolymerized with a modifying monomer within the definition of the instant (page lines 8-21; line 54 to page 4, line 2)

Prior art discussed above does not recite some of the recited properties, such as repulpability. The examiner is of the position that such properties, though not by the references, are considered inherent in prior art ABA block copolymer because the same monomers are used in both prior art and by the applicant. The burden placed upon the applicant to provide clear evidence that the respective adhesive compositions do in fact differ. In re Best, 195 USPQ 430, (CCPX 1977); In re Fitzgerald et al, 205 USPQ.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,723,407. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims disclose PSA comprising bvlock polymers composed essentially of the blocks having substantially the same characteristics (Tg) of the blocks and identical chemical make-up of the blocks, therefore, one skilled in the art would not be able to practice one invention without infringing the other one.

Claims 1-165 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,703,441. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims disclose PSA comprising bvlock polymers composed essentially of the blocks having substantially the same characteristics (Tg) of the blocks and identical chemical make-up of the blocks, therefore, one skilled in the art would not be able to practice one invention without infringing the other one. With regard to the properties that are not taught by the instant claims such as refractive properties,

they are inherent, since the compositions are essentially the same and are made by essentially the same process, as per ***In re Fitzgerald*** (205 USPQ 594). (CAFC).

12. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/123,625. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims disclose PSA comprising block polymers composed essentially of the blocks having substantially the same characteristics (Tg) of the blocks and identical chemical make-up of the blocks, therefore, one skilled in the art would not be able to practice one invention without infringing the other one.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Other prior art references cited in PTOL-892 show the PSA made of polymers similar to Applicants' polymers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (571) 272-1115. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tatyana Zalukaeva
Primary Examiner
Art Unit 1713

April 20, 2005